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| 09/847,656      | 05/03/2001  | Colin I'Anson        | 30003574 US         | 7310             |

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| EXAMINER |
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THEIN, MARIA TERESA T

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/847,656

Applicant(s)

I'ANSON ET AL.

Examiner

Marissa Thein

Art Unit

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*MW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on May 3, 2001 has been considered.

Most of the foreign patents cited have been considered, except the Japanese Patent JP-A-9212730, which did not have an English translation. The publication cited has not been considered because a copy could not be located in the case.

### ***Drawings***

The drawings filed on May 3, 2001 are acceptable.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely sending an enquiry message from an enquirer; the selecting of a trader in terms of location and type of item; and providing a way for the trader to response to the enquiry does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select a trader over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides an enquiry message which includes a description of an item used in determining and selecting the best-selected trader (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Furthermore regarding claims 1 and 21, claims directed to or including within its scope a **human** being will not be considered to be patentable subject matter under 25 USC 101. The grant of a limited but exclusive property right in a human being is

prohibited by the constitution. *In re Wakefield* 422 F.2d 897, 164 USPQ 636 (CCPA 1970)

### ***Claim Objections***

Claims 18-19 are objected to because of the following informalities:

"URI" should be --Uniform Resource Identification--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a store" is unclear and vague. Is the Applicant claiming a store or subsystem or database? For examining purposes, the Examiner will interpret as a database or subsystem for storing the description.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 5-17, 21, and 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No. 5,991,739 to Cupps et al.**

Regarding claim 1, Cupps discloses a shopping assistance, comprising the steps of:

- sending an enquiry message from an enquirer to a service system, the enquiry message including a description of an item of interest which description is intended and takes the form of image and/or unstructured audio data (see at least col. 2, lines 29-31; col. 2, lines 39-50; col. 8, line 43- col. 9, line 7; col. 9, lines 50-60);
- the service system (see at least col. 3, lines 49-56):
  - determining location associated with the enquiry(see at least col. 2, lines 25-29; col. 6, lines 19-30);
  - selecting from a database of traders, traders appropriate to the enquiry at least in terms of location and the type of the item of interest (see at least col. 2, lines 29-31; col. 6, lines 45-55; col. 7, line 66 – col. 8, line 6); and
  - forwarding the description of the item of interest to the selected traders in an availability enquiry (see at least col. 2, lines 24-29; col. 9, line 66 – col. 10, line 16); and
- providing a way for the selected trader to respond to the enquiry (see at least col. 2, lines 32-38; col. 8, lines 19-40).

Regarding claims 2, 5-7 and 24-25, Cupps discloses the location is the location of the enquirer (see at least col. 2, lines 24-29; col. 9, lines 50-57); the enquiry message includes a structured data part containing at least one type parameter for the item of

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interest, this at least one parameter being used in selecting the selected trader (see at least col. 2, lines 29-31; col. 2, lines 39-50; col. 8, line 43- col. 9, line 7; col. 9, lines 50-60); the service system is operative to process the description to extract at least one type parameter for the item of interest, this at least one parameter being used in selecting the traders (see at least col. 6, lines 45-56; col. 7, line 66- col. 8, line 6); the availability enquire contains contact information enabling a selected trader to directly contact the enquirer to inform the latter, on the basis of the description contained in the availability enquire, about the availability through the trader of items of the same type as the item of interest (see at least col. 8, lines 19-23; col. 8, lines 43-55; col. 10, lines 7-43).

Regarding claims 8-14 and 26-28, Cupps discloses the selected trader sends a response to the service system giving information about the availability through the trader of items of the same type as the item of interest; the service system forwards the response to enquirer; the service system stores the response and the enquirer subsequently contacts the service system and retrieves the response; the multiple selected traders provide respective responses to the service system, the service system collating the responses and forwarding them to the enquirer; the multiple selected traders provide respective responses to the service system, the service system collating the responses and storing them, the enquirer subsequently contact the service system and retrieving the collated responses; the enquirer having received a response via the service system and having decided that the response of interest, directly contacts the trader concerned using trader contact information contained in the response; and the

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direct contact is established by at least one of telephone, voice mail, fax, or e-mail (see at least col. 6, lines 44-56; col. 8, lines 19-24; col. 8, line 56 – col. 9, line 7; col. 9, lines 16-33; col. 10, line 44-col. 11, line 27; col. 10, lines 33-43).

Regarding claims 15-17 and 29-31, the enquirer having received a response via the service system and having decided that the response of interest, request the service system to establish live communication between the enquirer and trader concerned, the service system thereupon serving to mediate the establishment of direct live contact; the direct contact is established as a voice circuit via a telephone system; request the trader concerned, via service system to establish direct communication with the enquirer, this request including contact information for enabling the trader to contact the enquirer (see at least col. 8, lines 24-40; col. 10, line 33-56; col. 11, lines 13-34).

Regarding claim 21, Cupps discloses a shopping-assistance service system comprising:

- an enquiry-receiving subsystem for receiving an enquiry message from a remote enquirer over a communication network, the enquiry message including a description of an item of interest which description is intended and takes the form of image and/or unstructured audio data (see at least col. 2, lines 29-31; col. 2, lines 39-50; col. 8, line 43- col. 9, line 7; col. 9, lines 50-60);
- a store for at least temporarily storing the description (see at least Figure 1; col. 3, lines 49-55; col. 9, line 48-col. 10, line 6);



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- a location subsystem for automatically selecting from a database of traders, traders appropriate to the enquiry at least in terms of location and type of item of interest (see at least col. 2, lines 29-31; col. 6, lines 45-55; col. 7, line 66 – col. 8, line 6);
- an output subsystem for forwarding the description of the item of interest to the selected traders in a availability enquiry (see at least col. 2, lines 24-29; col. 9, line 66 – col. 10, line 16); and
- an enquirer-contact subsystem for providing a way for the selected traders to response to the enquiry (see at least col. 2, lines 32-38; col. 8, lines 19-40).

Regarding claim 23, Cupps discloses the location is included in the enquire message and the location subsystem is operative to extract this location from the enquiry message (see at least col. 2, lines 29-31; col. 2, lines 39-50; col. 8, line 43- col. 9, line 7; col. 9, lines 50-60).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5,991,739 to Cupps et al. in view of U.S. Patent No. 6,026,375 to Hall et al.**

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Regarding claims 3 and 22, Cupps substantially discloses the claimed invention, however, it does not disclose the mobile entity over a cellular radio infrastructure to the service system and determining the location of the enquirer from a location server of the cellular radio. Cupps disclose an online ordering machine, which is in communication using one or more telephone links (col. 3, lines 54-56). Furthermore, Cupps discloses the communication link is any type of wire or wireless link between computers (col. 3, lines 57-59). Hall, on the other hand, teaches the mobile entity over a cellular radio and the determination of the location of the enquirer from a location server of the cellular radio (col. 2, lines 49-61; col. 5, lines 38-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Cupps, to include the mobile entity over a cellular radio and the determination, as taught by Hall, in order to determine a facility capable of completing the order based on the customer's location (Hall col. 2, lines 29-31), so as to provide a user-friendly method that reduces or eliminates the time a customer in a mobile environment waits to receive an order (Hall col. 2, lines 24-26).

Regarding claim 4, Cupps substantially discloses the claimed invention, however, it does not disclose the location is a shopping location identified in the enquiry message by the enquirer. Cupps discloses an online ordering machine accepts orders from the customer for a particular product from a selected vendor (col. 2, lines 30-32). Hall, on the other hand, teaches the location is a shopping location identified in the enquiry message by the enquirer (col. 2, lines 49-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Cupps, to include the shopping location identified in the enquiry message, as taught by Hall, in order to eliminate or greatly reduce the time the customer spends waiting to receive goods or services (Hall col. 1, lines 19-21).

**Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5,991,739 to Cupps et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6,219,696 to Wynblatt et al.** Cupps substantially discloses the claimed invention, however, it does not disclose giving the URI where the enquirer can find information about items of the same type as the item of interest that are available through the trader and the URI to access the information. Cupps discloses the Internet access procedures; web server procedures; web pages (col. 4, lines 66-67; col. 5, lines 20-21). Wynblatt, on the other hand, teaches the URL que and a WWW renderer/browser (see at least col. 1, line 66 – col. 2, line 8; col. 3, lines 26-38). URI is defined as Uniform Resource Identifier, generic term for all types of names and addresses that refer to objects on the World Wide Web. A URL is one kind of URI. (Computer & Internet Dictionary 1999).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Cupps, to include the URI, as taught by Wynblatt, in order to provide a particular address of the vendor in the World Wide Web.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5,991,739 to Cupps et al.** Cupps substantially discloses the claimed

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invention, however, it does not disclose the identity of the enquirer not being disclosed. The difference is only found in the nonfunctional descriptive language and is not functionally involved in the steps recited. The not disclosing the identity of the enquirer would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to not disclose the identity of the enquirer such data does not functionally related to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication 2002/0002504 to Engel et al. discloses a mobile shopping assistance couple to a global positioning system and a global computer network facilitating a potential consumer's purchasing decision.

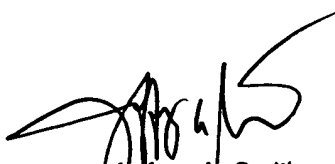
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
July 21, 2004



Jeffrey A. Smith  
Primary Examiner